



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,715	11/12/2003	John I. Shipp	127,0005-00000	7246
22882	7590	07/15/2008		
MARTIN & FERRARO, LLP 1557 LAKE O'PINES STREET, NE HARTVILLE, OH 44632			EXAMINER SONNETT, KATHLEEN C	
			ART UNIT 3731	PAPER NUMBER
			MAIL DATE 07/15/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/706,715

**Applicant(s)**

SHIPP, JOHN I.

**Examiner**

KATHLEEN SONNETT

**Art Unit**

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 and 27-34 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-24 and 27-34 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/14/2008 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 3-9, 12, 13, 15-22, 28, 29, 32, and 33** are rejected under 35 U.S.C. 102(b) as being anticipated by Chapman et al. (US 1,332,287). Chapman et al. discloses a clip, the clip comprising a mid-longitudinal axis, a distal and proximal end, and a length between the ends, an upper support member (5) oriented generally along the mid-longitudinal axis and a lower support member (6) oriented generally along the mid-longitudinal axis of the clip and a connector (11) at the proximal end of the clip, the connector joining the upper and lower support members, the clip being formed of a single piece of wire (fig. 4) having a first and second free end (14 and 17), each terminating proximate the proximal end (fig. 4). At least one of the upper and lower support members has a width at their distal ends perpendicular to the mid-longitudinal axis in a second plane generally parallel to the mid-longitudinal axis that is greater than the

Art Unit: 3731

maximum width of the connector (coil 11) in a first plane, the two planes generally parallel to each other (see fig. 3 which shows that the coil has a width less than that of the upper and lower jaws). The clip of Chapman et al. is capable of ligating a fluid carrying structure. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

3. Regarding claims 12 and 13, Chapman et al. discloses a clip comprising a mid-longitudinal axis, a distal and proximal end, and a length between ends, an upper support member and lower support member both being oriented generally along the mid-longitudinal axis of the clip between the ends of the clip and a connector. Chapman et al. discloses a connector (11) at the proximal end of the clip that joins the upper and lower support members, the clip being formed of a single piece of material having a first and second free end terminating proximate the proximal end. At least one of the free ends faces in a direction that is transverse to the mid-longitudinal axis of the clip (fig. 4).

4. Regarding claim 15, the ends (14, 17) face a direction generally transverse to the mid-longitudinal axis of the clip. This is considered away from the proximal end of the clip. That is, away from the proximal end does not necessarily mean towards the distal end, rather any direction besides toward the proximal end.

5. Regarding claims 3 and 16, see col. 2 ll. 57-60.

6. Regarding claims 4 and 17, the clip is a coiled torsion spring clip and is adapted to clip onto objects.

7. Regarding claims 5, 6, 18, and 19, the connector includes a coil having an interior, the first and second ends of the wire terminating proximate the interior of the coil (fig. 4).

Art Unit: 3731

8. Regarding claims 7 and 20, see (20) and (28).
9. Regarding claims 8, 21, 28, 29, 32, and 33, each support member is formed of first and second longitudinal legs with a recess therebetween, which extend generally parallel to one another from the connector. The legs of the upper support member generally overlie the legs of the lower support member (see fig. 2 and note "generally overlie").
10. Regarding claims 9 and 22, the longitudinal members extend along a substantial portion of the length of the clip.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-24, 28-30, and 32-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shipp et al. (US 5,858,018) in view of Crainich (US 6,226,843). Shipp et al. discloses a surgical ligation clip for ligating a fluid carrying structure, the clip comprising a mid-longitudinal axis, a distal and proximal end, and a length between the ends, an upper support member (22) oriented generally along the mid-longitudinal axis and a lower support member (20) oriented generally along the mid-longitudinal axis of the clip and a connector (24) at the proximal end of the clip, the connector joining the upper and lower support members, the clip being formed of a single piece of wire (fig. 4) having a first and second free end, the free end of the lower support member terminating proximate the proximal end (fig. 2b; within coil). At least one of the upper and lower support members has a width at their distal ends perpendicular to the mid-longitudinal axis in a second plane generally parallel to the mid-longitudinal axis that is

Art Unit: 3731

greater than the maximum width of the connector (fig. 2b; fig. 4b, and 10b, see clip) in a first plane, the two planes generally parallel to each other.

12. Regarding claims 12 and 13, Chapman et al. discloses a clip comprising a mid-longitudinal axis, a distal and proximal end, and a length between ends, an upper support member and lower support member both being oriented generally along the mid-longitudinal axis of the clip between the ends of the clip and a connector. Chapman et al. discloses a connector (24) at the proximal end of the clip that joins the upper and lower support members, the clip being formed of a single piece of material having a first and second free end, one of the free ends terminating proximate the proximal end. At least one of the free ends faces in a direction that is transverse to the mid-longitudinal axis of the clip (end that terminates in coil).

13. Shipp et al. fails to disclose that the second free end terminates proximal to the connector since the upper support member does not loop back around like the lower support member. However, Crainich teaches that a well known alternative to having a lower support with two legs and an upper support with a single leg (see fig. 9) is a clip with lower and upper supports that both have two parallel legs generally aligned to one another (fig. 11). Since Shipp et al. discloses that the clip is manufactured by a single piece of wire and Crainich teaches that the configuration shown in fig. 11 is a known alternative to the configuration shown in fig. 9, it would have been obvious to one skilled in the art to have modified the device of Shipp et al. to extend the upper support so that it can loop around and form a two leg upper support as is well known in the art of spring clips. It would have been obvious to one skilled in the art to try the configuration taught by Crainich for the device of Shipp et al. because a person of ordinary skill has good reason to pursue the known options within his technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Art Unit: 3731

14. Regarding claim 2, see col. 2 ll. 39-42 which indicates that titanium wire of 0.75 mm can be used to manufacture the clip.
15. Regarding claims 3, 4, 16, and 17, see col. 4 ll. 4-7.
16. Regarding claims 9 and 22, the longitudinal members extend along a substantial portion of the length of the clip.
17. Regarding claims 10, 11, 23, and 24, see col. 10, ll. 12-21.
18. Regarding claims 5, 6, 18, and 19, the connector includes a coil having an interior, the free end of the lower support member of the wire terminating proximate the interior of the coil (fig. 2b). As discussed above, Crainich teaches adding another leg for the upper support member so that it lies on top of the lower support member in a configuration similar to that shown in fig. 11 of Crainich. It would have been obvious to one skilled in the art to have put the free end of the upper support proximate the interior of the coil as it is well known in the art of wire spring clips to include both free ends of the wire within the coil in order to prevent material from catching on the free ends of the wire.
19. Regarding claims 7 and 20, Crainich teaches upper and lower support members each having two parallel longitudinal members with a recess therebetween, the upper support members generally overlying the lower support members. The lower support member includes a loop at its distal and it would have been obvious to similarly construct the upper support member to achieve the configuration taught by Crainich in fig. 11.
20. Regarding claims 8, 21, 28, 29, 32, and 33, each support member is formed of first and second longitudinal legs with a recess therebetween, which extend generally parallel to one another from the connector. The legs of the upper support member generally overlie the legs of the lower support member (see fig. 2 and note "generally overlie").

Art Unit: 3731

21. Regarding claims 13 and 15, the ends face a direction generally transverse to the mid-longitudinal axis of the clip of the device of Shipp et al. as modified by Crainich. As discussed above, Shipp et al. only includes one free end within the coil but it would have been obvious, after attaining the configuration taught by Crainich, to place the other free end of the clip within the coil as well to avoid This is considered away from the proximal end of the clip. That is, away from the proximal end does not necessarily mean towards the distal end, rather any direction besides toward the proximal end.

22. Regarding claims 28, 29, 32, and 33, the upper and lower support members are formed of first and second legs extending parallel to one another as taught by Crainich.

23. Regarding claims 30 and 34, to better see the structure of the clip, applicant is directed to US 5,593,414. The disclosure of Shipp et al. '018 references this clip. (col. 1, line 66-col. 2 ll. 2; Applier to be used with clip of US application no. 08/111,634, now abandoned, of which US 5,593,414 is a continuation). Fig. 5 of '414 shows the width of the coil being less than that of the distal end of the lower support member.

24. Regarding claim 14, Shipp et al. in view of Crainich fails to disclose one of the free ends facing generally toward the distal end. However, applicant has not disclosed any advantage gained, purpose served, or problem solved by having a free end facing toward the distal end as opposed to facing a direction transverse to the mid-longitudinal axis of the clip. It appears that the claimed invention and the invention of Shipp et al. in view of Crainich would work equally well with the ends facing in either of these directions since they are protected by the coil. Therefore, such a configuration can be considered a design consideration that fails to patentably distinguish the invention of claim 14 from the prior art of Shipp et al. in view of Crainich.



Art Unit: 3731

25. **Claims 27 and 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shipp et al. '018 in view of Crainich as applied to claims 1 and 12 above, and further in view of Shipp (US 6,290,575). Shipp et al. '018 in view of Crainich discloses the invention substantially as stated above but fails to disclose that at least one of the upper and lower support members is enlarged at a distal end of the clip. However, Shipp '575 discloses that such a configuration for clips is known (fig. 3 and 4). It would have been obvious to one skilled in the art to include the enlarged ends taught by Shipp '575 on the device of Shipp et al. '018 because a person of ordinary skill has good reason to pursue the known options within his technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

### ***Response to Arguments***

26. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendment to the claims.

27. It is noted that applicant's arguments regarding the examiner's designation of the proximal half of the clips of Kees Jr. (US 4,777,950) and Perlin (US 4,777,949) as the proximal end are not found persuasive. However, each of these references fails to disclose a distal end of a support member with a width as claimed that is greater than the maximum width of the connector.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHLEEN SONNETT whose telephone number is (571)272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

Art Unit: 3731

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCS 6/20/2008

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3731